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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,769	10/22/2001	Sin Hui Cheah	RCA 89521	6467
7590	12/15/2004		EXAMINER	
Joseph S Tripoli Thomson Multimedia Licensing PO Box 5312 Princeton, NJ 08543-5312			VO, HUYEN X	
			ART UNIT	PAPER NUMBER
			2655	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,769

Applicant(s)

CHEAH ET AL.

Examiner

Huyen Vo

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/22/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4 and 9 contain the trademark/trade name compactflash. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a memory and, accordingly, the identification/description is indefinite. The examiner interprets that compactflash memory as flash memory.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (US Patent No. 6118870) in view of Kato et al. (US Patent No. 6301993).

5. Regarding claim 1, Boyle et al. disclose that in a portable audio data processing apparatus comprising a micro-controller coupled to a digital signal processor, the apparatus having a key file and a decryption program stored therein, the apparatus adapted to be removably coupled to a data storage device having a unique identifier, an audio data file and a decoder file stored therein, a method for processing the audio data file (*figures 2 or 5-6*), the method comprising the steps of:

identifying a key stored in a memory of the micro-controller in response to the decryption program (*col. 4, ln. 1-37, public and private keys*); retrieving the audio data file and the decoder file from the data storage device in response to a user selection of the audio data file (*figure 3 or col. 8, ln. 49 to col. 9, ln. 40*); decrypting the decoder file in response to the first key and the decryption program (*col. 6, ln. 7-25 or col. 9, ln. 5-34, the EPLAY program is the decoder file*); generating a key in response to a key stored in the memory of the microcontroller (*col. 9, ln. 1-10*); decrypting the audio data file in response to the generated key and the decryption program (*col. 5, ln. 54 to col. 6, ln. 5*); decoding the decrypted audio data file in response to the decrypted decoder file (*col. 6, ln. 7-25*); and providing the decrypted, decoded audio data file to an output device (*element 348 in figure 5, ready for display or output to speakers*).

Boyle et al. fail to specifically disclose a second the step of using two separate keys to decrypt the decoder file and the audio data. However, Kato et al. teach the step

of decrypting the audio data using a different key from Boyle et al. (*col. 7, ln. 53 to col. 8, ln. 35*).

Since Boyle et al. and Kato et al. are analogous art because they are from the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Boyle et al. by incorporating the teaching of Kato et al. in order to enhance data security.

6. Regarding claim 6, Boyle et al. disclose a portable audio data processing apparatus, comprising:

user input means for receiving user inputs, data input means for receiving digital data (*col. 8, ln. 49-57*); a data storage device having an audio data file, a decoder file and a unique identifier stored therein, the data storage device adapted to be removably coupled to the data input means (*Secure Buffer 40 in figure 2 or referring to figure 3*); a digital signal processor (*CPU of figure 2*); and a micro-controller coupled to the user input means, data input means, and digital signal processor (*figure 2*), the micro-controller transferring a decryption program and a key file to the digital signal processor in response to the data storage device being coupled to the data input means (*elements 34, 38, and 40 in figure 2*), the digital signal processor identifying a key stored in a memory of the micro-controller in response to the decryption program (*col. 4, ln. 1-37, public and private keys*), the micro-controller transferring the audio data file, the decoder file and the unique identifier from the data storage device to the digital signal processor in response to user selection of the audio data file (*col. 4, lines 43-67*), the digital signal

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processor decrypting the decoder file in response to the first key and the decryption program (*col. 4, lines 43-67*), the digital signal processor decrypting the audio data file in response to a key, the unique identifier and the decryption program, the digital signal processor decoding the decrypted audio data file in response to the decoder file (*col. 4, lines 43-67 and col. 18, lines 25-31*).

Boyle et al. fail to specifically disclose a second the step of using two separate keys to decrypt the decoder file and the audio data. However, Kato et al. teach the step of decrypting the audio data using a different key from Boyle et al. (*col. 7, ln. 53 to col. 8, ln. 35*).

Since Boyle et al. and Kato et al. are analogous art because they are from the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Boyle et al. by incorporating the teaching of Kato et al. in order to enhance data security.

7. Regarding claims 2 and 7, Boyle et al. further disclose a method and apparatus of claims 1 and 6, wherein the steps of identifying the first key and the second key comprise identifying a first memory location having the first key stored therein and identifying a second memory location having the second key stored therein (*col. 4, lines 1-67, public and private keys are stored in two different locations*).

8. Regarding claims 3-4 and 8-9, Boyle et al. further disclose a method and apparatus of claims 2 and 6, wherein the data storage device is a solid-state memory device (*col. 4, ln. 44-47*), a flash memory card (*col. 4, ln. 44-47*).

9. Regarding claims 5 and 10, Boyle et al. fail to specifically disclose the method of claims 1 and 6, wherein the data storage device includes a plurality of audio data files and decoder files stored therein, each one of the plurality of audio data files being associated with a selected one of the decoder files, the retrieving step comprising identifying a selected decoder file associated with the audio data files and retrieving the audio data file and the selected decoder file in response to the user selection.

Kato et al. teach that the data storage device includes a plurality of audio data files and decoder files stored therein, each one of the plurality of audio data files being associated with a selected one of the decoder files, the retrieving step comprising identifying a selected decoder file associated with the audio data files and retrieving the audio data file and the selected decoder file in response to the user selection (*col. 18, ln. 25-31*).

Since Boyle et al. and Kato et al. are analogous art because they are from the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Boyle et al. by incorporating the teaching of Kato et al. in order correctly and effectively decode audio files having different format.

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10. Regarding claim 11, Boyle et al. further disclose a compact memory device for storing digital data, the memory device adapted to be coupled to a handheld audio playback device, the memory device comprising:

a plurality of memory cells, the memory cells having stored therein:

a unique identifier associated with the compact memory device;

an audio data file having audio data encoded in accordance with a selected one of a plurality of encoding formats and encrypted using a first key stored in a micro-controller of the playback device (*col. 3, lines 36-52*);

a decoder file associated with the selected one of a plurality of encoding formats, the decoder file encrypted using the unique identifier and a second key stored in the micro-controller of the playback device (*col. 4, lines 1-67*), the decoder file being adapted to be transferred to a digital signal processor for causing the digital signal processor to decode the audio data file in accordance with the selected one of a plurality of encoding formats (*col. 4, lines 43-67*).

Boyle et al. fail to specifically disclose an identifier data file for identifying the correspondence between the audio data file and the associated decoder file. However, Kato et al. teach an identifier data file for identifying the correspondence between the audio data file and the associated decoder file (*col. 18, ln. 25-31*).

Since Boyle et al. and Kato et al. are analogous art because they are from the same field of endeavor, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Boyle et al. by incorporating the teaching of Kato et al. in order correctly and effectively decode audio files having different formats.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Vo whose telephone number is 703-305-8665.


The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on 703-305-4827. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Huyen X. Vo

December 9, 2004


SUSAN MCFADDEN
PRIMARY EXAMINER